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### **REMARKS/ARGUMENTS**

Responsive to the Official Action mailed March 24, 2004, Applicants provide the following remarks. Reconsideration and allowance of the subject application, as amended, are respectfully requested.

#### **Priority**

The Examiner indicated that the instant application "is a continuation of application 09/960453, which claims priority to provisional application 60/234442. However, the provisional application upon which priority is claimed, 60/23442, is expired." Applicants respectfully submit an effective claim to multiple prior applications has been made. As clarified in Section 201.11 of the MPEP, "sometimes a pending application is one of a series of applications wherein the pending application is not copending with the first filed application but is copending with an intermediate application entitled to the benefit of the filing date of the first application." Section 201.11 of MPEP under Section C titled "Benefit Claims to Multiple Prior Applications."

The MPEP goes on to clarify, in citing the In re Henricksen case, 399 F.2d 253, 158 USPQ 224 (CCPA 1968), that "[t]here is no limit to the number of prior applications through which a chain of copendency may be traced to obtain the benefit of the filing date of the earliest of a chain of prior copending applications." Section 201.11 of the MPEP. Furthermore, the MPEP goes on to clarify that in the case of a provisional application, a nonprovisional application may not be filed within the twelve month period after the provisional application, but may properly claim the benefit of an intermediate nonprovisional application that was filed

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within twelve months from the filing date of the provisional and claimed the benefit of the provisional application. See also Section 201.11 of the MPEP.

Therefore, in this case, the expiration of the provisional application is not relevant since an "intermediate" application (Serial Number 09/960,453) was filed during copendency of the provisional application, and the present application Serial Number 10/685,043 is a proper continuation application of that "intermediate" application. (The nonprovisional "intermediate" patent application Serial Number 09/960,453 was filed on September 21, 2001 and claimed the benefit of the provisional application 60/234,442 that was filed on September 21, 2000.) Thus, a proper chain of copendency that can be traced back to the earliest filing date of the provisional patent application is present.

#### Oath

The Examiner indicated that the Oath is defective because the oath indicates priority to the now expired provisional application and that the oath does not mention that the instant application is a continuation application of a previously filed application. Applicants respectfully submit that the oath is effective. See the earlier arguments regarding the effectiveness of the claim to the provisional patent application through the chain of copending prior applications.

In addition, as detailed by Rule 63 (37 CFR 1.63) and specified in section 201.06(c) of the MPEP: "37 CFR 1.63(d) provides that a newly executed oath or declaration is not required in a continuation ... application filed by all or by fewer than all of the inventors named in a prior nonprovisional application containing a signed oath or declaration as required by 37 CFR 1.63,

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provided that a copy of the signed oath or declaration filed in the prior application is submitted for the continuation ... application and the specification and drawings filed in the continuation ... application do not contain any subject matter that would have been new matter in the prior application." MPEP 201.06(c). The present continuation application is filed by all of the inventors named in the prior nonprovisional application Serial Number 09/960,453. A copy of the signed oath was provided, and the specification and drawings filed in the continuation application do not contain any new matter.

#### **Double Patenting**

Enclosed is a Terminal Disclaimer to obviate the double patenting rejection over the patented U.S. Application No. 09/960,453 (now U.S. Patent No. 6,741,066). Therefore, no specific discussion of the Double Patenting rejection is believed necessary. Also enclosed is a credit card authorization form authorizing a charge in the amount of \$220.00 to cover the \$110 Terminal Disclaimer Fee, as well as the \$110 fee for a one month extension of time.

#### **35 USC §103 Claim Rejections**

The Examiner rejected claims 7 - 14, 16, 17, and 19 - 29 under 35 USC §103 as being unpatentable over Gaza (U.S. Patent No. 5,764,030). Claim 7 is directed at an adapter comprising "a PWM generator ... generating a PWM signal in response to a feedback signal from an external device representative of a power condition of said external device." The Examiner acknowledges that Gaza discloses a pulse width modulator only in its battery charger circuit 22. The Examiner then indicates the location of the pulse width modulators, "i.e., with

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the power supply/AC adapter, absent any criticality, is only considered to be an obvious modification."

Applicants respectfully disagree. The criticality of placing the PWM generator in the adapter and "generating a PWM signal in response to a feedback signal from an external device" is described in Applicant's specification. In particular, Applicants' specification indicates "in the exemplary embodiments, the need for a PWM generator and controller, as well as power switches and a DC/DC converter are eliminated in the charger circuit, thereby economizing power topologies, as well as removing heat-generating portions of a conventional battery charger circuit to the external AC/DC adapter." Page 4, lines 6 – 10. In addition, the ability to remove components in the charger circuit enables printed circuit board space to be saved. Page 7, lines 13 – 14 of Applicant's specification. Furthermore, this allows the adapter to be remotely controlled by the feedback signal from the external device.

Therefore, Applicants respectfully submit the Examiner's rejection claim 7 as being obvious in view of Gaza is in error, and should be withdrawn. Claim 8 - 12 are dependent claims that depend directly or indirectly from claim 7 and as such incorporate all the limitations of claim 7. Accordingly, Applicants respectfully submit that claims 8 - 12 are in condition for allowance by virtue of their dependence from claim 7, as well as for their own limitations.

Claim 13 is directed at an electronic device comprising a "controller configured to generate a feedback signal representative of a power condition of said electronic device, wherein an adapter comprises a PWM generator generating a PWM signal in response to said feedback signal to adjust an output DC signal from said adapter in response to said feedback signal." As earlier adduced regarding claim 7, Gaza does not teach, disclose, or suggest an adapter

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comprising a PWM generator comprising a PWM generator responsive to a feedback signal as required by claim 13. The criticality of placing the PWM generator in the adapter was earlier detailed with respect to claim 7.

Therefore, Applicants respectfully submit the Examiner's rejection claim 13 as being obvious in view of Gaza is in error, and should be withdrawn. Claim 14 and 16 - 22 are dependent claims that depend directly or indirectly from claim 13 and as such incorporate all the limitations of claim 13. Accordingly, Applicants respectfully submit that claims 14 and 16 - 22 are in condition for allowance by virtue of their dependence from claim 13, as well as for their own limitations.

The Examiner also rejected claim 15 under 35 USC 103 as being unpatentable over Gaza in view of Bryson (U.S. Pat. No. 6,144,187). Applicants have cancelled, without prejudice, claim 15. Accordingly, the Examiner's rejection of claim 15 is now moot.

The Examiner also rejected claim 18 under 35 USC 103 as being unpatentable over Gaza in view of Irvin (U.S. Pat. No. 6,029,074). Claim 18 depends from claim 13 and as such incorporates all the limitations of claim 13. Claim 13 is directed at an electronic device comprising a "controller configured to generate a feedback signal representative of a power condition of said electronic device, wherein an adapter comprises a PWM generator generating a PWM signal in response to said feedback signal to adjust an output DC signal from said adapter in response to said feedback signal." As earlier adduced regarding claim 7, Gaza does not teach, disclose, or suggest an adapter comprising a PWM generator comprising a PWM generator responsive to a feedback signal as required by claim 13. Irvin is directed at hand held cellular telephone with power management features and does not supply this missing teaching.

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Therefore, Applicants respectfully submit the Examiner's rejection claim 18 as being obvious over Gaza in view of Irvin is in error, and should be withdrawn.

Claim 23 is a method claim requiring: "providing a feedback signal to said adapter representative of said power condition of said external device; adjusting a PWM signal generated by said adapter in response to said feedback signal; and adjusting said DC power signal provided by said adapter in response to said PWM signal."

As earlier adduced regarding claim 7, Gaza does not teach, disclose, or suggest "adjusting a PWM signal generated by said adapter in response to said feedback signal." Rather, the PWM generator taught by Gaza is in the battery charger circuit 22 and is responsive to a signal from the microcontroller 30 of FIG. 3B of Gaza. The criticality of placing the PWM generator in the adapter was earlier detailed with respect to claim 7. In addition, Gaza teaches that the output DC signal provided by its adapter 28 is "a function of the highest sensed battery voltage." Column 4, line 16. This is generally because Gaza is concerned with providing "a dual pocket battery charger which alternatively charges batteries in the two pockets on a time slice basis." Column 1, lines 28 - 29.

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Accordingly, Applicants respectfully submit that in light of the foregoing claim amendments and remarks, all of the presently pending claims are now in a condition for allowance. Reexamination and reconsideration are respectfully requested. Early allowance is earnestly solicited. In the event the Examiner deems personal contact desirable in disposition of this application, the Examiner is respectfully requested to call the undersigned attorney at (603) 668-6560. In the event any additional fees are payable, please charge them to our Deposit Account No. 50-2121.

Respectfully submitted,



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Attachments Appendix A "replacement" sheet 1  
Petition for Extension of Time  
Terminal Disclaimer  
Credit Card Authorization